

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to claims 4, 7, 11 and 12, cancellation of claims 1 – 3, 6, 10 and 19 - 24, and addition of new claims 25 - 30, filed on November 12, 2008, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Objections***

3. Claims 13 – 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

4. Claims 4, 7 – 9, 16 – 18 and 26 – 30 are rejected under 35 U.S.C. 102(a), (b) and/or (e) as being anticipated by Naito et al. (U.S. Patent No. 6,850,480 B1 and/or EP 1091355 A2) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on June 12, 2008, as evidenced by Bennin et al. (U.S. Patent No. 5,864,445).

Regarding the amended limitation(s) “wherein the slider comprises a conductive member and functions as a return electrode for returning an electric field applied from

the recording/reproducing electrode to the dielectric recording medium” this is (an) intended use limitation(s) and is not further limiting in so far as the structure of the product is concerned except for the requirement that at least a portion of the slider must comprise a conductive member. Note that “in apparatus, article, and composition claims, intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. **If the prior art structure is capable of performing the intended use, then it meets the claim.** In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. The Examiner notes that Naito et al. discloses a conductive member as it pertained to original claim 6 (i.e. *that a slider would inherently contain at least one conductive member in order to deliver current to the disclosed head*). For support of the Examiner’s position, see evidentiary art Bennin et al. (Figures 24 and 25; col. 1, line 1 bridging col. 3, line 14; col. 4, lines 12 – 32; and col. 13, line 65 bridging col. 14, line 28: which essentially teaches a head slider assembly for all types of dynamic recording, wherein it is well established that the slider can be grounded and includes conductive lead/electrical (i.e. conductive) terminals attached to the head).

Regarding new claims 26, 29 and 30, Naito et al. disclose recording/reproducing apparatus (*Title and Figures*).

Regarding new claim 27, the Examiner notes that "a grounded conductive member" is an intended use limitation, but that it is met for the same reason a "conductive layer" is met – i.e. that the Examiner takes the position that grounded conductive layers are well established in the art (see *Bennin et al.*, Figures 24 and 25 and col. 13, line 65 bridging col. 14, line 28). Furthermore, the Examiner notes that one of ordinary skill in the art would readily appreciate that a *grounded* lead is necessary to avoid static charge build up, which is undesirable in any sort of recording/reproducing application.

Regarding new claim 28, these limitations are met as described with regard to original claim 7 (see also *Bennin et al.* disclosure).

### ***Claim Rejections - 35 USC § 103***

5. Claims 7, 11, 12, 16 – 18 and 25 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naito et al. as evidenced by Bennin et al as applied above, and as further evidenced by Takanashi et al. (EP 39856 A or U.S. Patent No. 5,226,029 A). See U.S. '029 A, which is the US equivalent to EP '656 A (see provided Derwent Abstract Translation).

Naito et al. and Bennin et al. are relied upon as described above.

Takanashi et al. is relied upon for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on June 12, 2008

Regarding new claim 25, these limitations are met for substantially the same reasoning as applied to original claim 12.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naito et al. as evidenced by Bennin et al. as applied above, and further in view of Kim et al. (EP 1154422 A1 and/or U.S. Patent No. 7,020,064 B2). See U.S. '064 B2, which is the US equivalent to EP '422 A1 (see provided Derwent Abstract Translation).

Naito et al. and Bennin et al. are relied upon as described above.

Kim et al. is relied upon for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on June 12, 2008

#### ***Allowable Subject Matter***

7. Claims 13 – 15 are deemed allowable for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on June 12, 2008.

#### ***Response to Arguments***

8. **The rejection of claims 4, 5, 7 - 9, 11 - 18 and 25 - 30 under 35 U.S.C § 102 and/or 103 – Naito et al., including evidentiary art and supplemental art**

Applicant(s) argue(s) that Naito et al. fails to meet the claimed intended use limitations of the electrode. The Examiner respectfully disagrees.

As noted by the included evidentiary reference, grounded, conductive leads/electrodes are well established in the art as being formed on sliders to provide current to the head. Applicants are reminded that an invention may be obvious if the prior art has different reasons for doing what the applicant has done. “It has long been

held that a rejection under 35 USC 103 based upon a combination of references is not deficient solely because the references are combined based upon a reason or technical consideration which is different from that which resulted in the claimed invention.” *Ex parte Raychem Corp.* 17 USPQ 2d 1417, 1424 (BPAI 1990). Cites *In re Kronig* 190 USPQ 425 (CCPA 1976); *In re Gershon* 152 USPQ 602 (CCPA 1967).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicants' amendment resulted in embodiments not previously considered (i.e. new claims 25 - 30) which necessitated the new grounds of rejection, and hence the finality of this action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin M. Bernatz whose telephone number is (571) 272-1505. The Examiner can normally be reached on M-F, 8:30 AM - 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kevin M Bernatz/  
Primary Examiner, Art Unit 1794

February 26, 2009